



**DEPARTMENT OF COMMERCE**

**[3510-16]**

**United States Patent and Trademark Office**

**37 CFR Parts 2 and 7**

**[Docket No. PTO-T-2013-0027]**

**RIN 0651-AC89**

**Changes in Requirements for Collective Trademarks and Service Marks, Collective Membership Marks, and Certification Marks**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTIONS:** Final rule.

**SUMMARY:** The United States Patent and Trademark Office (“USPTO”) is amending the rules related to collective trademarks, collective service marks, and collective membership marks (together “collective marks”), and certification marks to clarify application requirements, allegations of use requirements, multiple-class application requirements, and registration maintenance requirements for such marks. These rule changes codify current USPTO practice set forth in the USPTO’s “Trademark Manual of Examining Procedure” (“TMEP”) and precedential case law. These changes also permit the USPTO to provide the public more detailed guidance regarding registering and maintaining registrations for these types of marks and promote the efficient and consistent processing of such marks. Further, the USPTO is

amending several rules beyond those related to collective marks and certification marks to create consistency with rule changes regarding such marks and to streamline the rules, by consolidating text and incorporating headings, for easier use.

**DATES:** This rule is effective on July 11, 2015.

**FOR FURTHER INFORMATION CONTACT:** Cynthia Lynch, Office of the Deputy Commissioner for Trademark Examination Policy, at (571) 272-8742 or [tmpolicy@uspto.gov](mailto:tmpolicy@uspto.gov).

## **SUPPLEMENTARY INFORMATION**

Executive Summary: Purpose: As noted above, the revised rules benefit the public by providing more comprehensive and specific guidance regarding registering collective marks and certification marks. The current rules incorporate by reference the trademark and service mark application rules; however, wording in the trademark and service mark application rules sometimes may not be specifically suited to collective and certification mark applications. Therefore, the USPTO is revising the rules in parts 2 and 7 of title 37 of the Code of Federal Regulations to codify current USPTO practice in TMEP sections 1302, 1303 et seq., 1304, and 1306, and to state clearly and provide sufficient detail regarding the requirements for collective and certification mark applications. The USPTO is also harmonizing registration maintenance requirements with application requirements where appropriate.

Further, rule changes beyond those related to collective marks and certification marks provide consistency with changes made regarding those marks and streamline the rules, by consolidating text and incorporating headings, for easier use.

To provide additional context for the ensuing discussion of the amended and revised rules regarding collective marks and certification marks, the following is a brief description of those types of marks.

There are two types of collective marks as defined by section 45 of the Trademark Act of 1946, as amended (“the Act”): (1) collective trademarks or collective service marks; and (2) collective membership marks. 15 U.S.C. 1127. A collective trademark or collective service mark is used by members of a collective organization to identify and distinguish their goods or services from those of nonmembers. TMEP section 1303. By contrast, collective membership marks are used by members of a collective organization to indicate membership in the collective membership organization. TMEP section 1304.02.

Certification marks are used by authorized users to indicate the following: (1) goods or services have been certified as to quality, materials, or mode of manufacture; (2) goods or services have been certified to originate in a specific geographic region; and/or (3) the work or labor on goods or for services was certified to have been performed by a member of a union or other organization, or to certify that the performer meets certain standards. TMEP section 1306.01. A certification mark is similar to a collective trademark or collective service mark except that the users are not members of a collective organization. See TMEP section 1306.09(a). That is, a collective trademark or collective service mark is used by members of an organization who meet the collective organization’s standards of admission, while a certification mark is used by parties whose products or services meet the certifying organization’s established standards.

Summary of Major Provisions: As stated above, the USPTO is revising the rules in parts 2 and 7 of title 37 of the Code of Federal Regulations to codify current USPTO practice in TMEP sections 1302, 1303 et seq., 1304, and 1306, and to state clearly, and provide additional detail regarding, the requirements for collective and certification mark applications, as well as to harmonize registration maintenance requirements with application requirements where appropriate. Further, the USPTO is revising additional rules within these parts for consistency and clarity.

Costs and Benefits: This rulemaking is not economically significant under Executive Order 12866 (Sept. 30, 1993).

### **Proposed Rule and Request for Comments**

The proposed rule was published in the **Federal Register** on February 20, 2014, at 79 FR 9678, and in the Official Gazette on April 8, 2014. The USPTO received comments from two intellectual property organizations. These comments are posted on the USPTO's website at [http://www.uspto.gov/trademarks/law/Fr\\_Notice\\_comments.jsp](http://www.uspto.gov/trademarks/law/Fr_Notice_comments.jsp) and are addressed below.

The following rules are amended: §§ 2.2, 2.20, 2.22, 2.32-2.35, 2.41-2.42, 2.44-2.45, 2.56, 2.59, 2.71, 2.74, 2.76, 2.77, 2.86, 2.88-2.89, 2.146, 2.161, 2.167, 2.173, 2.175, 2.183, 2.193, 7.1, and 7.37.

## **PART 2: RULES OF PRACTICE IN TRADEMARK CASES**

### **Rules Applicable to Trademark Cases**

The USPTO is amending § 2.2, regarding definitions, and adding terms to this section to enable the deletion of repetitious wording in the rules wherever possible. Specifically, § 2.2(h) is

amended to clarify that the definition of “international application” is limited to an application seeking an extension of protection of an international registration in an initial designation. Also, § 2.2(i) through (n) is added to set forth the following new definitions: subsequent designation; holder; use in commerce or use of the mark in commerce; bona fide intention to use the mark in commerce; bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; and verified statement, verify, verified, or verification.

## **Declarations**

The USPTO is revising § 2.20, regarding declarations in lieu of oaths, as follows: in the introductory text, delete “verification” to correspond with the definition of that term in § 2.2(n), and add the term “declaration;” in the second paragraph delete “undersigned” and replace it with “signatory” and delete “document” and replace it with “submission.”

## **Application for Registration**

The USPTO is amending § 2.22(a)(8) to delete the language “and at <http://www.uspto.gov>” to codify current USPTO practice that the identification in a TEAS Plus application must be selected from the USPTO’s “U.S. Acceptable Identification of Goods and Services Manual” available in the TEAS Plus application form.

The USPTO is amending the rule title of § 2.32 to “Requirements for a complete trademark or service mark application.” In addition, § 2.32(f) is added to cross-reference § 2.44 for the requirements for collective mark applications, and § 2.32(g) is added to cross-reference § 2.45 for the requirements for certification mark applications.

The USPTO is revising § 2.33, regarding verified statements for trademarks or service

marks, to ensure the language corresponds with other rules, including the definitions in § 2.2. Section 2.33 is also revised as follows: amend the rule title to “Verified statement for a trademark or service mark;” revise § 2.33(e)(1) to include language similar to the current rule, “that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation;” revise § 2.33(e)(3), to correspond with § 2.33(e)(1), and to amend “international application/registration” to “international application/subsequent designation;” and add § 2.33(f) to set forth the type of verified statement required for concurrent use applications under § 2.42. Further, in response to a comment submitted regarding § 2.34(a)(1)(i), the USPTO is amending § 2.33(c) slightly for purposes of consistency with § 2.34(a)(1)(i), (a)(2), (a)(3)(i), and (a)(4)(ii); § 2.44(b); and § 2.45(b).

The USPTO is amending § 2.34, regarding filing bases for trademark or service mark applications, to ensure the language corresponds with other rules, including the new definitions in § 2.2; to delete the definition of “commerce” in current § 2.34(c) as redundant of section 45 of the Act; and to correct a typographical error. Further, the rule title is amended to “Bases for filing a trademark or service mark application.” Section 2.34(a)(1)(iv) is also amended to delete “actually” as a redundant term for consistency with amendments to § 2.56(b)(2) and (c) regarding specimens, § 2.76(b)(2) regarding amendments to allege use, and § 2.88(b)(2) regarding statements of use. Lastly, § 2.34(b)(1)-(3) is revised by condensing the text in § 2.34(b), and adding the title “More than one basis.”

Comment: One commenter noted that, in § 2.34(a)(1)(i) where the verification is not filed with the initial application, that rule appeared to require an applicant to aver that the mark “has been” in continuous use as of the application filing date; that is, when subsequently filing the verified statement, a declarant must affirm that the mark is in use as of the initial application

filing date and has been in continuous use from that date until the date the verification is submitted. The commenter suggested retaining the language in the current rule and using “was in use in commerce as of the application filing date.” The commenter similarly noted that this comment applies to the subsections relating to applications filed under section 1(b) or 44 of the Act.

Response: The commenter’s suggestion is adopted. The language in the current rule has always been interpreted as including a presumption that an applicant’s use or bona fide intent is continuous after filing an application; thus, the current language is acceptable and sufficient to incorporate that presumption. Thus, the USPTO will retain “was in use in commerce” in § 2.34(a)(1)(i) and “had a bona fide intention” in § 2.34(a)(2), (a)(3)(i), and (a)(4)(ii). In addition, § 2.33(c), § 2.44(b), and § 2.45(b) are revised to correspond with the changes made to these subsections.

The USPTO is revising § 2.35, regarding adding, deleting, or substituting bases, to include the requirements for collective marks and certification marks for consistency with revisions made to § 2.44(c). Specifically, § 2.35 is amended as follows: in § 2.35(b)(1), add cross-references to § 2.44 and § 2.45 for requirements for a new basis in a collective or certification mark application; in § 2.35(b)(6), add “or collective membership organization” to indicate which goods, services, or organization the added or substituted basis will apply; in § 2.35(b)(7), add “or collective membership organization” to indicate which goods, services, or organization were covered by the deleted basis; and in § 2.35(b)(8), add text to clarify that an applicant may not amend an application to seek both sections 1(b) and 1(a) of the Act for identical goods or services or the same collective membership organization.

The USPTO is revising § 2.41, regarding proof of distinctiveness under section 2(f) of the Act, to specify the type of proof required to establish such a claim for trademarks, service marks, collective marks, and certification marks, and to make other changes consistent with current USPTO practice. Specifically, § 2.41 is revised as follows: in § 2.41(a), add the title “For a trademark or service mark” and set forth in § 2.41(a)(1)-(3) most of the current text in existing § 2.41; and in § 2.41(b), add the title “For a collective trademark or collective service mark” and set forth in § 2.41(b)(1)-(3) the requirements for collective trademarks or collective service marks. The following is also added to § 2.41: in § 2.41(c), set forth the requirements for collective membership marks; and in § 2.41(d), set forth the requirements for certification marks. Further, additional revisions in § 2.41 are added to correspond with the new definitions in § 2.2 and to include subsections with subheadings that set forth the three types of proof that can be submitted to establish distinctiveness under 15 U.S.C. 1052(f). In addition, § 2.41(a)(1), (c)(1), and (d)(1) add the term “active” to clarify and codify current USPTO practice, see TMEP section 1212.04(d), that evidence of distinctiveness must be based on ownership of an active prior registration on the Principal Register or under the Trademark Act of 1905. Further, § 2.41(a)(1) and (d)(1) clarify that such registration must be for goods or services sufficiently similar to those in the application, and § 2.41(c)(1) adds that the nature of the collective membership organization must be sufficiently similar to the collective membership organization in the application, such that these requirements in § 2.41(a)(1), (d)(1), and (c)(1) codify precedential case law and current USPTO practice. See In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001), In re Rogers, 53 USPQ2d 1741, 1744 (TTAB 1999), TMEP sections 1212.04(c), 1212.09(a). Lastly, § 2.41(e) excludes from § 2.41(d)

geographic matter in certification marks certifying regional origin, because 15 U.S.C. 1052(e)(2) does not apply to such terms. See TMEP section 1306.02.

Comment: One commenter suggested that § 2.41(e) be revised to clarify further that, although geographic indications are considered certification marks, § 2.41(d) does not apply to geographic indications of origin. The commenter suggested revising § 2.41(e) as follows: “Paragraph (d) does not apply to geographical matter in a certification mark certifying regional origin because section 2(e)(2) of the Act does not apply to certification marks that are indications of regional origin.”

Response: The USPTO agrees with this further clarification and adopts the commenter’s suggestion.

The USPTO is revising § 2.42, regarding concurrent use requirements, to incorporate requirements for collective marks and certification marks, as well as to make other changes consistent with current USPTO practice. Specifically, the USPTO is adding § 2.42(a) to require an application for registration for lawful concurrent use to assert use in commerce in accordance with current USPTO practice, see TMEP section 1207.04(b), and the USPTO’s “Trademark Trial and Appeal Board Manual of Procedure” section 1101.01, and that such application be for a mark seeking registration on the Principal Register under the Act, in accordance with current § 2.99(g), and include all relevant application requirements, including § 2.44 for collective marks or § 2.45 for certification marks, if applicable. In addition, § 2.42(b) is added to enumerate the additional requirements for concurrent use applications set forth in the existing second sentence of current § 2.42 and to modify such text to incorporate the requirements for collective marks and certification marks. Further, § 2.42(c) is added to cross-reference current § 2.73, pertaining

to amending an application to recite concurrent use, and § 2.42(d) is added to cross-reference current § 2.99, pertaining to concurrent use proceedings at the Trademark Trial and Appeal Board.

The USPTO is revising § 2.44, regarding collective marks, to include all requirements for a collective mark application in one rule. Specifically, § 2.44 is revised as follows: in § 2.44(a), enumerate the application requirements for a collective mark, incorporating the relevant application requirements from current § 2.32, regarding the requirements for a complete trademark or service mark application, current § 2.44, and current USPTO practice, see TMEP sections 1303.02 et seq. for collective trademarks and collective service marks, and TMEP section 1304.08(c)-(f) for collective membership marks; and in § 2.44(b), specify the requirements for a verified statement that was not filed within a reasonable time after signing or was omitted from the application to correspond primarily with § 2.33(c) and § 2.34(a)(1)(i), (a)(2), (a)(3)(i), and (a)(4)(ii). In addition, the following is added to § 2.44: in § 2.44(c), specify the requirements for claiming more than one filing basis in the application to correspond with § 2.34(b); in § 2.44(d), specify the requirements for the verification in a concurrent use application to correspond with § 2.33(f); and in § 2.44(e), cross-reference the multiple-class application requirements rule in § 2.86 for consistency with § 2.32(e). Further, § 2.44 is revised to correspond with the new definitions in § 2.2. Also, the rule title is amended to “Requirements for a complete collective mark application” for consistency with the rule title of § 2.32 regarding trademark and service mark application requirements. Further, § 2.44(a)(4)(v) is slightly revised, to correspond with § 2.33(e)(1), to amend the language to include “that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation.” Additionally, in response to a comment submitted

regarding § 2.34(a)(1)(i), the USPTO is further amending § 2.44(b) to correspond with slight changes to § 2.33(c); § 2.34(a)(1)(i), (a)(2), (a)(3)(i), and (a)(4)(ii); and § 2.45(b). Finally, § 2.44(c) is further revised to clarify that an applicant may claim more than one filing basis in a collective membership mark application.

The USPTO is revising § 2.45, regarding certification marks, to include all requirements for a certification mark application in one rule, and to be consistent with the formatting of § 2.44 for collective mark application requirements. Specifically, § 2.45 is revised as follows: in § 2.45(a), enumerate the application requirements for a certification mark, incorporating the relevant application requirements from current § 2.32, regarding the requirements for a complete trademark or service mark application, current § 2.45, and current USPTO practice, see TMEP sections 1306.06 et seq.; and in § 2.45(b), specify the requirements for a verified statement that was not filed within a reasonable time after signing or was omitted from the application to correspond primarily with § 2.33(c) and § 2.34(a)(1)(i), (a)(2), (a)(3)(i), and (a)(4)(ii) and § 2.44(b). In addition, the following is added to § 2.45: in § 2.45(c), specify the requirements for claiming more than one filing basis in the application to correspond with § 2.34(b) and § 2.44(c); in § 2.45(d), specify the requirements for the verification in a concurrent use application to correspond with § 2.33(f) and § 2.44(d); in § 2.45(e), cross-reference the multiple-class application requirements rule in § 2.86 for consistency with § 2.32(e) and § 2.44(e); and in § 2.45(f), prohibit a single application from including both a certification mark and another type of mark, because the USPTO's databases preclude capturing different legal requirements for multiple types of marks in a single application, and also prohibit the registration of the same mark for the same goods and/or services as both a certification mark and another type of mark, in accordance with sections 4 and 14(5)(B) of the Act and current USPTO practice, see TMEP

section 1306.05(a). Further, § 2.45 is revised to correspond with the new definitions in § 2.2. Also, the rule title is amended to “Requirements for a complete certification mark application; restriction on certification mark application” for consistency with the rule title of § 2.32 regarding trademark and service mark application requirements and § 2.44 regarding collective mark application requirements. Additionally, § 2.45(a)(4)(v)(B) is slightly revised, to correspond with § 2.33(e)(1), to amend the language to include “that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation.” Finally, in response to a comment submitted regarding § 2.34(a)(1)(i), the USPTO is further amending § 2.45(b) to correspond with slight changes to § 2.33(c); § 2.34(a)(1)(i), (a)(2), (a)(3)(i), and (a)(4)(ii); and § 2.44(b).

## **Specimens**

The USPTO is amending § 2.56(b)(2) and (c), regarding specimens, to delete the term “actually” as a redundant term and for consistency with similar amendments to § 2.34(a)(1)(iv), § 2.76(b)(2), § 2.88(b)(2), and § 2.161(g). Additionally, § 2.56(b)(5) is amended to delete “to certify” and replace it with “to reflect certification of.” Lastly, § 2.56(d)(3), regarding bulky specimens, is revised as follows: “In the absence of non-bulky alternatives, another appropriate medium may be designated as acceptable by the Office.”

Comment: One commenter suggested that § 2.56(d)(3), pertaining to bulky specimens, be revised to omit references to specific forms of media because of the rapid evolution of technology related to such media and to minimize future amendments to this rule. The commenter suggested revising this rule to “In the absence of non-bulky alternatives, the Office may accept a specimen of use in any appropriate medium.”

Response: The USPTO agrees that technology related to data storage media is rapidly evolving and that listing specific types of media could require amendment to this rule at a subsequent date. Thus, the USPTO is revising § 2.56(d)(3) to omit references to specific forms of media and to state that, in the absence of non-bulky alternatives, another appropriate medium may be designated as acceptable by the USPTO.

The USPTO is amending § 2.59, regarding substitute specimens, to change existing text to “verified statement” to correspond with § 2.2(n). Additionally, § 2.59(a) and (b) are amended to reference substitute specimens for a collective membership mark.

### **Amendment of Application**

The USPTO is amending § 2.71(a), regarding amendments to the identification of goods and/or services, to reference amending the description of the nature of a collective membership mark. In addition, § 2.71(b)-(d) is amended to change existing text to correspond with § 2.2(n). Further, § 2.71(e) is added to set forth that an amendment that would materially alter a certification statement pursuant to § 2.45(a)(4)(i)(A) and (a)(4)(ii)(A), is not permitted, which is consistent with § 2.173(f) regarding such amendments after registration.

The USPTO is amending § 2.74(b), regarding the form and signature of an amendment, to change existing text to cross-reference the definition of “verification” in § 2.2(n).

The USPTO is amending § 2.77(a)(1), regarding permissible amendments submitted between a notice of allowance and the filing of a statement of use, to include deletion of the entire identification for a collective membership mark.

The USPTO is amending § 2.76, regarding amendments to allege use, to include the relevant requirements for collective marks and certification marks, and to be consistent with § 2.88 for statements of use. Specifically, § 2.76 is amended as follows: in § 2.76(a), add the title “When to file an amendment to allege use;” in § 2.76(a)(1) and (a)(2), include most of the text from current § 2.76(a) and (c), except amend the language in the last sentence of current § 2.76(a)(1) regarding the USPTO returning an untimely filed amendment to allege use to indicate that under current practice the USPTO will not review such an amendment, see TMEP section 1104.03(b)-(c), and the last sentence in current § 2.76(c), which is slightly amended and moved to § 2.76(b)(1)(iii); in § 2.76(b), add the title “A complete amendment to allege use” and include in § 2.76(b)(1)-(5) the text from current § 2.76(b) and (c) and the requirements for collective marks and certification marks, and in § 2.76(b)(6), require the title “Amendment to Allege Use” at the top of the first page of the document for those documents not filed using the Trademark Electronic Application System (TEAS); in § 2.76(c), add the title “Minimum filing requirements for a timely filed amendment to allege use” and include the text from current § 2.76(e) and change existing text to “verified statement” to correspond with § 2.2(n); in § 2.76(d), add the title “Deficiency notification” and include the text from current § 2.76(g); in § 2.76(e), add the title “Notification of refusals and requirements” and include most of the text from current § 2.76(f), except the second to last sentence regarding the USPTO providing notification of acceptance of an amendment to allege use because current practice is that a notice of approval for publication provides such notice, and the last sentence which is slightly amended and moved to § 2.76(h); in § 2.76(f), add the title “Withdrawal” and include the text from current § 2.76(h); in § 2.76(g), add the title “Verification not filed within reasonable time,” and include the text from current § 2.76(i) and change existing text to “verified statement” to correspond with

§ 2.2(n); in § 2.76(h), add the title “An amendment to allege use is not a response but may include amendments,” include slightly revised text from the last sentence of current § 2.76(f), and clarify that an amendment to allege use may include amendments in accordance with § 2.59 and § 2.71 through § 2.75; in § 2.76(i), specify the requirements for the verification in a concurrent use application under § 2.42; and in § 2.76(j), add the title “Multiple-class application.” Additionally, the USPTO is further amending § 2.76(g) for consistency with revisions made in response to a comment to § 2.34(a)(1)(i) regarding bases for filing a trademark or service mark application and to include the relevant statement for collective marks and certification marks. Finally, the USPTO is further amending § 2.76(i) slightly for consistency with revisions made to § 2.88(i) for a statement of use after a notice of allowance.

## **Classification**

The USPTO is amending § 2.86, regarding multiple-class application requirements, to include the requirements for collective marks and certification marks, and to make other changes consistent with current USPTO practice. Specifically, § 2.86 is amended as follows: set forth the rule title as “Multiple-class applications;” in § 2.86(a), set forth the requirements for a single trademark, service mark, and/or collective mark application for multiple classes, clarifying that such an application must satisfy either the trademark or service mark application requirements in § 2.32 or the collective mark application requirements in § 2.44, in addition to providing the applicable goods, services, or nature of the collective membership organization in each appropriate international or U.S. class, and providing a fee, dates of use, and a specimen for each class based on use in commerce or a bona fide intent statement for each class based on section 1(b), 44, or 66(a) of the Act; in § 2.86(b), set forth the requirements for a single certification mark application for goods and services, clarifying that such multiple-class application must

satisfy the certification mark application requirements in § 2.45, in addition to identifying the applicable goods and services in each appropriate U.S. class for applications filed under section 1 or 44 of the Act or in the international classes assigned by the World Intellectual Property Organization's International Bureau for applications filed under section 66(a) of the Act, and providing a fee, dates of use, and a specimen for each class based on use in commerce or a bona fide intent statement for each class based on section 1(b), 44, or 66(a) of the Act; and in § 2.86(c), amend to include the text in the last sentence of current § 2.86(a)(3) regarding an applicant not claiming both section 1(a) and 1(b) of the Act for identical goods or services in a single application. In addition, the following is added to § 2.86: in § 2.86(d), restrict a single application based on section 1 or 44 of the Act from including goods or services in U.S. Classes A and/or B and either goods or services in any international class or with a collective membership organization in U.S. Class 200, and restrict a single application based on section 66(a) of the Act from including goods, services, or a collective membership organization in any international class, for consistency with § 2.45(f); in § 2.86(e), add the text from current § 2.86(b) regarding multiple-class requirements for amendments to allege use and statements of use; and in § 2.86(f), add the text in current § 2.86(c) regarding issuing a single registration certificate for multiple-class applications.

### **Post Notice of Allowance**

The USPTO is amending § 2.88, regarding statements of use, to include the relevant requirements for collective marks and certification marks, and to be consistent with § 2.76 for amendments to allege use. Specifically, § 2.88 is amended as follows: set forth the rule title as "Statement of use after notice of allowance;" in § 2.88(a), add the title "When to file a statement of use;" in § 2.88(a)(1), include most of the text from current § 2.88(a), except delete the

language regarding the USPTO returning a premature statement of use filed prior to issuance of a notice of allowance because under current practice the USPTO will not return or review it, see TMEP section 1109.04; in § 2.88(a)(2), include most of the text from current § 2.88(c), except for the last sentence which is slightly amended and moved to § 2.88(b)(1)(iii); in § 2.88(b), add the title “A complete statement of use,” include in § 2.88 (b)(1)-(3) the text from current § 2.88(b), in § 2.88(b)(1)(iii) additionally include most of the last sentence from current § 2.88(c), in § 2.88(b)(1)(iv) additionally include the text from current § 2.88(i)(1)-(2), in § 2.88 (b)(6) require the title “Statement of Use” at the top of the first page of the document for those documents not filed using the TEAS, and in § 2.88(b) incorporate the requirements for collective marks and certification marks and change text to “verified statement” to correspond with § 2.2(n); in § 2.88(c), add the title “Minimum filing requirements for a timely filed statement of use,” include the text in current § 2.88(e), and change text to “verified statement” to correspond with § 2.2(n); in § 2.88(d), add the title “Deficiency notification” and include the text from current § 2.88(g), except for the last sentence; in § 2.88(e), add the title “Notification of refusals and requirements” and include the text from current § 2.88(f), except delete the language regarding the USPTO providing notification of acceptance of a statement of use because the registration certificate provides such notice; in § 2.88(f), add the title “Statement of use may not be withdrawn” and include the text in the last sentence of current § 2.88(g); in § 2.88(g), add the title “Verification not filed within reasonable time,” include the text from current § 2.88(k), and change existing text to “verified statement” to correspond with § 2.2(n); in § 2.88(h), add the title “Amending the application,” include the text from the second to last sentence of current § 2.88(f), and specify that statements of use may include amendments in accordance with § 2.51, § 2.59, and § 2.71 through § 2.75, as the TEAS on-line statement of use form will now accept

such amendments within the same form; in § 2.88(i), add the requirements for the verification in a concurrent use amendment under § 2.42; in § 2.88(j), add the title “Multiple-class application” and include the text from current § 2.88(l); and in § 2.88(k), add the title “Abandonment” and include the text from current § 2.88(h). Finally, the USPTO is further amending § 2.88(g) for consistency with revisions made in response to a comment to § 2.34(a)(1)(i) regarding bases for filing a trademark or service mark application and to include the relevant statement for collective marks and certification marks.

Comment: One commenter requested clarification that § 2.88(i) would apply only in the rare circumstances in which an applicant submitted a proper amendment for concurrent use in a section 1(b) application and satisfied the jurisdictional requirements for concurrent use under 15 U.S.C. 1052(d).

Response: Because an applicant must assert use in commerce prior to seeking concurrent use, the USPTO clarifies that a proper amendment for concurrent use submitted with an amendment to allege use under § 2.76 or statement of use under § 2.88 would be rare. The USPTO further clarifies that for such an amendment to be acceptable the amendment must satisfy both the requirements of § 2.73 for amending an application to concurrent use and the jurisdictional requirements under 15 U.S.C. 1052(d) for concurrent use. In addition, the USPTO is amending § 2.76(i) and § 2.88(i) slightly to clarify that an allegation of use must include a modified verified statement if the application is amended to concurrent use under § 2.73.

The USPTO is amending § 2.89, regarding submitting a request for an extension of time to file a statement of use (“extension request”), to include the relevant requirements for collective marks and certification marks, as well as to make other changes consistent with

current USPTO practice. Section 2.89 is amended as follows: in § 2.89(a), add the title “First extension request after issuance of notice of allowance;” in § 2.89(a)(3), change text to “verified statement” to correspond with § 2.2(n), and incorporate the requirements for collective marks and certification marks; in § 2.89(b), add the title “Subsequent extension requests” and a cross-reference in § 2.89(b)(2) to § 2.89(a)(2), as the fee requirements are the same for first and subsequent extension requests; in § 2.89(c), add the title “Four subsequent extension requests permitted;” in § 2.89(d), add the title “Good cause,” enumerate in § 2.89(d)(1)-(3) the requirements for showing good cause for all marks, including collective marks and certification marks, and include the text from current § 2.89(d) in (d)(1); in § 2.89(e), add the title “Extension request filed in conjunction with or after a statement of use” and amend the current text for clarity; in § 2.89(f), add the title “Goods or services” and incorporate the requirements for collective marks and certification marks; in § 2.89(g), add the title “Notice of grant or denial;” and in § 2.89(h), add the title “Verification not filed within reasonable time,” incorporate the requirements for collective marks and certification marks, and change text to “verified statement” to correspond with § 2.2(n). Further, the USPTO is amending § 2.89(a)(3), (b)(3), and (h) for consistency with revisions made in response to a comment to § 2.34(a)(1)(i) regarding bases for filing a trademark or service mark application.

#### Petitions and Action by the Director

The USPTO is amending § 2.146(c), regarding petitions to the Director, to change existing text to “verified statements” to correspond with § 2.2(n). Additionally, § 2.146(d) is amended to specify that a petition regarding a cancelled or expired registration must be submitted to the USPTO within two months of the date when USPTO records are updated to

show the registration as cancelled or expired, to ensure that all interested parties will be able to accurately determine the deadline for filing a petition under these circumstances.

### **Cancellation for Failure to File Affidavit or Declaration**

The USPTO is amending § 2.161, regarding affidavits or declarations of use in commerce or excusable nonuse under section 8 of the Act, to include the relevant requirements for collective marks and certification marks, to change text to correspond with § 2.2, and to make other changes consistent with current USPTO practice. Section 2.161(g) is revised to cross-reference current § 2.56 regarding specimens and delete § 2.161(g)(1)-(3), as similar language appears in current § 2.56. Section 2.161(h) is revised to incorporate the language from current § 2.161(h)(1) into § 2.161(h) and to delete current § 2.161(h)(2)-(3), because the sunset provision in § 2.161(h)(2)-(3), in which § 2.161(h)(2) will no longer be applied after June 21, 2014 to affidavits or declarations filed under section 8 of the Act, has expired. Section 2.161(i) and (j) are added, as follows, to include requirements for collective marks and certification marks to harmonize the USPTO's post registration practice with current examination practice, and to be consistent with § 7.37(i)-(j), regarding affidavits or declarations of use in commerce or excusable nonuse under section 71 of the Act: in § 2.161(i), add the title "Additional requirements for a collective mark" and the additional requirements for such marks, see TMEP sections 1303.01, 1303.02(c)(i), 1304.08(f)(i)-(ii); in § 2.161(j), add the title "Additional requirements for a certification mark" and the additional requirements for such marks, see TMEP section 1306.06(f)(i)-(iii), (f)(v). Section 2.161(k) is added to cross-reference to § 7.37 regarding the requirements for a complete affidavit or declaration of use in commerce or excusable nonuse for a registration with an underlying application based on section 66(a) of the Act.

## **Affidavit or Declaration Under Section 15 of the Act**

The USPTO is amending § 2.167, regarding an affidavit or declaration of incontestability under section 15 of the Act, to include the relevant requirements for collective marks and certification marks, to change text to “verified” to correspond with § 2.2(n), and to make other changes consistent with current USPTO practice. Specifically, § 2.167(f) is amended to delete the last sentence of the current rule because, under current USPTO practice, notification acknowledging receipt of the affidavit or declaration only issues if the requirements of § 2.167(a) through (g) have been satisfied, consistent with § 2.167(i). See TMEP section 1605. Also § 2.167(h), (i), (j), and (k) are added, as follows, to clarify current USPTO practice: in § 2.167(h), clarify that notification will be provided to an owner if an affidavit or declaration cannot be acknowledged when the affidavit or declaration fails to satisfy any requirements in paragraphs § 2.167(a) through (g), and that the affidavit or declaration will be abandoned if a response is not received in the time specified in the notification; in § 2.167(i), clarify that a notice of acknowledgement will only issue if an affidavit or declaration satisfies § 2.167(a) through (g); in § 2.167(j), clarify that an affidavit or declaration may be abandoned by petitioning the Director under § 2.146 either before or after a notice of acknowledgement issues; and in § 2.167(k), clarify that a new affidavit or declaration with a new fee may be filed if an affidavit or declaration is abandoned. See TMEP section 1605.

## **Correction, Disclaimer, Surrender, Etc.**

The USPTO is amending § 2.173, regarding an amendment to a registration, to include the relevant requirements for collective marks and certification marks, to change text to correspond with § 2.2, and to make other changes consistent with current USPTO practice.

Section 2.173 is amended as follows: in § 2.173(b)(2), cross-reference § 2.193(e)(6), regarding trademark signature requirements, and delete the language in this subsection that is similar to wording in current § 2.193(e)(6); in § 2.173(d), clarify that an amendment that would materially alter the mark will not be permitted in accordance with section 7(e) of the Act; in § 2.173(e), amend the title to “Amendment of identification of goods, services, or collective membership organization,” and the text to add a reference to a description of the nature of the collective membership organization; and in § 2.173(f), amend the title to “Amendment of certification statement for certification marks” and set forth the prohibition regarding amending a certification statement, as specified in § 2.45(a)(4)(i)(A) and (a)(4)(ii)(A), in accordance with section 7(e) of the Act and for consistency with § 2.71(e). Section 2.173(f) is redesignated as § 2.173(g), and § 2.173(g) is redesignated as § 2.173(h). Section 2.173(i) is added with the heading “No amendment to add or delete a section 2(f) claim of acquired distinctiveness,” clarifying that the USPTO will not permit an amendment seeking the addition or elimination of a claim of acquired distinctiveness, just as an owner cannot amend a registration from the Supplemental to the Principal Register. See TMEP section 1609.09.

The USPTO is amending § 2.175(b)(2), regarding correcting an owner’s mistake, to change text to “verified” to correspond with § 2.2(n).

### **Term and Renewal**

The USPTO is amending § 2.183(d), regarding requirements for a renewal application, to specify that a renewal application may cover less than all the classes in a registration, in addition to covering less than all the goods or services in a registration.

### **General Information and Correspondence in Trademark Cases**

The USPTO is amending § 2.193, regarding trademark correspondence and signature requirements, to correct a typographical error in § 2.193(c)(2), to change current text in § 2.193(e)(1) to correspond with § 2.2(n), and to revise the final sentence of § 2.193(f) to delete reference to § 10.23(c)(15) and instead refer to § 11.804, as part 10 of this chapter has been removed and reserved and the content in current § 11.804 corresponds with content previously set out in § 10.23.

## **PART 7: RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

### **Subpart A – General Information**

The USPTO is amending § 7.1, regarding definitions, to add § 7.1(f), which incorporates by reference the definitions in § 2.2(k) and (n), to apply to filings pursuant to the Protocol relating to the Madrid Agreement concerning the international registration of marks.

### **Subpart F – Affidavit Under Section 71 of the Act for Extension of Protection to the United States**

The USPTO is amending § 7.37, regarding affidavits or declarations of use in commerce or excusable nonuse under section 71 of the Act, to include the relevant requirements for collective marks and certification marks and to change text to correspond with § 2.2. Specifically, § 7.37(h) is revised to incorporate the language from current § 7.37(h)(1) into § 7.37(h) and to delete current § 7.37(h)(2)-(3), because the sunset provision in § 7.37(h)(2)-(3), in which § 7.37(h)(2) will no longer be applied after June 21, 2014 to affidavits or declarations filed under section 71 of the Act, has expired. Section 7.37(i) and (j) are added, as follows, to

include requirements for collective marks and certification marks so as to harmonize the USPTO's post registration practice with current examination practice, and to be consistent with § 2.161(i)-(j), regarding affidavits or declarations of use in commerce or excusable nonuse under section 8 of the Act: in § 7.37(i), add the title "Additional requirements for a collective mark" and the additional requirements for such marks, see TMEP sections 1303.01, 1303.02(c)(i), 1304.08(f)(i)-(ii), 1904.02(d); in § 7.37(j), add the title "Additional requirements for a certification mark" and additional requirements for such marks, see TMEP sections 1306.06(f)(i)-(iii), (f)(v), 1904.02(d).

### **Rulemaking Requirements**

Administrative Procedure Act: The changes in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See Perez v. Mortg. Bankers Ass'n, 135 S. Ct. 1199, 1204 (2015) (interpretive rules "advise the public of the agency's construction of the statutes and rules which it administers") (citation and internal quotation marks omitted); Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive); Bachow Commc'ns Inc. v. FCC, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); Inova Alexandria Hosp. v. Shalala, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims).

Accordingly, prior notice and opportunity for public comment for the changes in this rulemaking are not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. See Perez, 135 S. Ct. at 1206 (notice-and-comment procedures are required neither when an agency "issue[s] an

initial interpretive rule” nor “when it amends or repeals that interpretive rule”); Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice,” quoting 5 U.S.C. 553(b)(A)). The USPTO, however, chose to seek public comment before implementing the rule as the USPTO seeks the benefit of the public’s views regarding collective and certification marks.

Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a Regulatory Flexibility Act analysis, nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601, et seq.), is required. See 5 U.S.C. 603.

In addition, for the reasons set forth herein, the Deputy General Counsel for General Law of the USPTO has certified to the Chief Counsel for Advocacy of the Small Business Administration that rule changes in this document will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b).

To the extent the rule changes in this document primarily codify current USPTO practice set forth in the TMEP and precedential case law regarding collective marks and certification marks, those rule changes impose no new burdens on applicants and registration owners/holders. Some rule changes harmonize registration maintenance requirements with current application requirements. The USPTO is also changing current practice regarding maintenance requirements regarding certification marks to require filers of the first affidavit of use after registration in registrations based on sections 44 and 66(a) of the Act to submit certification standards, and to require that all filers of such affidavits submit updated standards if the standards have changed or

a statement indicating they have not. The USPTO does not collect or maintain statistics in trademark cases on small versus large entity applicants, and this information would be required in order to precisely calculate the number of small entities that would be affected. However, these rule changes will have no impact on the vast majority of trademark owners/holders, and only a slight effect on the very small subset of certification mark registrations, where standards previously have not been provided, or change post registration. Certification marks account for approximately 0.2% of the total number of registered marks in the USPTO database (approximately 4,000 registrations out of a total of approximately 2,000,000 registrations). For fiscal year 2014, affidavits of use for all filers have totaled approximately 248,000 of which approximately 0.2%, or 496 affidavits, were submitted for certification mark registrations. Of those 496 affidavits, only a small subset will be required to include certification standards or revised standards. Even in the event that standards must be submitted, the burden is quite minimal, as it merely involves attaching an already existing document to a filing that must otherwise be made to maintain the registration. For these reasons, the rule changes will not have a significant economic impact on a substantial number of small entities.

Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563 (Jan. 18, 2011). Specifically, the USPTO has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule changes; (2) tailored the rules to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives;

(6) provided the public with a meaningful opportunity to participate in the regulatory process, including soliciting the views of those likely affected prior to issuing a notice of proposed rulemaking, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes, to the extent applicable.

Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), prior to issuing this final rule, the USPTO has submitted the required report containing the final rule and other required information to the U.S. Senate, the U.S. House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this document are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this document is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

Unfunded Mandates Reform Act of 1995: The changes set forth in this rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State,

local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

Paperwork Reduction Act: This rulemaking involves information collection requirements which are subject to review by the U.S. Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.). The USPTO has determined that there would be no new information collection requirements or impacts to existing information collection requirements associated with this rulemaking. The collections of information involved in this rulemaking have been reviewed and previously approved by OMB under control numbers 0651-0009, 0651-0050, 0651-0051, 0651-0054, 0651-0055, 0651-0056, and 0651-0061.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

## **List of Subjects**

### **37 CFR Part 2**

Administrative practice and procedure, Trademarks.

### **37 CFR Part 7**

Administrative practice and procedure, Trademarks, International Registration.

For the reasons given in the preamble and under the authority contained in 15 U.S.C. 1123 and 35 U.S.C. 2, as amended, the USPTO is amending parts 2 and 7 of title 37 as follows:

## **PART 2—RULES OF PRACTICE IN TRADEMARK CASES**

1. The authority citation for 37 CFR part 2 continues to read as follows:

**Authority:** 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

2. Amend § 2.2 by revising paragraphs (f) and (h) and adding paragraphs (i) through (n) to read as follows:

### **§ 2.2 Definitions.**

\* \* \* \* \*

(f) The acronym TEAS means the Trademark Electronic Application System, available at <http://www.uspto.gov>.

\* \* \* \* \*

(h) The term international application as used in this part means, in addition to the definition in section 60 of the Act, an application seeking an extension of protection of an international registration in an initial designation filed under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

(i) The term subsequent designation as used in this part means a request for extension of protection of an international registration made after the International Bureau registers the mark on the International Register.

(j) The term holder as used in this part means, in addition to the definition of a “holder of an international registration” in section 60 of the Act, the natural or juristic person in whose name

an international registration seeking an extension of protection to the United States is recorded on the International Register.

(k) The term use in commerce or use of the mark in commerce as used in this part means, in addition to the definition of “use in commerce” in section 45 of the Act:

(1) For a trademark or service mark, use of the mark in commerce by an applicant, owner, or holder on or in connection with the goods or services specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse;

(2) For a collective trademark or collective service mark, use of the mark in commerce by members on or in connection with the goods or services specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse;

(3) For a collective membership mark, use of the mark in commerce by members to indicate membership in the collective organization as specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse; and

(4) For a certification mark, use of the mark in commerce by authorized users on or in connection with the goods or services specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse.

(l) The term bona fide intention to use the mark in commerce as used in this part means, for a trademark or service mark, that an applicant or holder has a bona fide intention to use the mark in commerce on or in connection with the goods or services specified in a U.S. application or international application/subsequent designation.

(m) The term bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce as used in this part means:

(1) For a collective trademark or collective service mark, that an applicant or holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the goods or services specified in a U.S. application or international application/subsequent designation;

(2) For a collective membership mark, that an applicant or holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce by members to indicate membership in the collective organization as specified in a U.S. application or international application/subsequent designation; and

(3) For a certification mark, that an applicant or holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce by authorized users on or in connection with the goods or services specified in a U.S. application or international application/subsequent designation.

(n) The term verified statement, and the terms verify, verified, or verification as used in this part refers to a statement that is sworn to, made under oath or in an affidavit, or supported by a declaration under § 2.20 or 28 U.S.C. 1746, and signed in accordance with the requirements of § 2.193.

3. Revise § 2.20 to read as follows:

**§ 2.20 Declarations in lieu of oaths.**

Instead of an oath, affidavit, or sworn statement, the language of 28 U.S.C. 1746, or the following declaration language, may be used:

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration

resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

4. Amend § 2.22 by revising paragraph (a)(8) to read as follows:

**§ 2.22 Filing requirements for a TEAS Plus application.**

(a) \* \* \*

(8) Correctly classified goods and/or services, with an identification of goods and/or services from the Office's *Acceptable Identification of Goods and Services Manual*, available through the TEAS Plus form. In an application based on section 44 of the Act, the scope of the goods and/or services covered by the section 44 basis may not exceed the scope of the goods and/or services in the foreign application or registration;

\* \* \* \* \*

5. Amend § 2.32 by revising the section heading and paragraphs (a)(3)(iii), (a)(6), (c), and (e) and adding paragraphs (f) and (g) to read as follows:

**§ 2.32 Requirements for a complete trademark or service mark application.**

(a) \* \* \*

(3) \* \* \*

(iii) If the applicant is a domestic partnership, the names and citizenship of the general partners; or

\* \* \* \* \*

(6) A list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark. In a U.S. application filed under section 44 of the Act, the scope of the goods or services covered by the section 44 basis may not exceed the scope of the goods or services in the foreign application or registration;

\* \* \* \* \*

(c) The application must include a drawing that meets the requirements of § 2.51 and § 2.52.

\* \* \* \* \*

(e) For the requirements of a multiple-class application, see § 2.86.

(f) For the requirements of all collective mark applications, see § 2.44.

(g) For the requirements of a certification mark application, see § 2.45.

6. Revise § 2.33 to read as follows:

**§ 2.33 Verified statement for a trademark or service mark.**

(a) The application must include a verified statement.

(b)(1) In an application under section 1(a) of the Act, the verified statement must allege:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of such other person, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used on or in connection with the goods or services; and that the facts set forth in the application are true.

(2) In an application under section 1(b) or 44 of the Act, the verified statement must allege:

That the applicant has a bona fide intention to use the mark in commerce; that the applicant believes the applicant is entitled to use the mark in

commerce on or in connection with the goods or services specified in the application; that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of such other person, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(c) If the verified statement in paragraph (b)(1) or (2) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that the mark was in use in commerce as of the application filing date, or the applicant had a bona fide intention to use the mark in commerce as of the application filing date.

(d) [Reserved]

(e) In an application under section 66(a) of the Act, the verified statement, which is part of the international registration on file with the International Bureau, must allege that:

(1) The applicant/holder has a bona fide intention to use the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation;

(2) The signatory is properly authorized to execute the declaration on behalf of the applicant/holder;

(3) The signatory believes the applicant/holder to be entitled to use the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation; and

(4) To the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity has the right to use the mark in commerce that the U.S. Congress can regulate either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

(f) In an application for concurrent use under § 2.42, the verified statement in paragraph (b)(1) of this section must be modified to indicate that no other person except as specified in the application has the right to use the mark in commerce.

7. Amend § 2.34 by revising the section heading and paragraphs (a) introductory text, (a)(1) introductory text, (a)(1)(i), (a)(1)(iii) through (v), (a)(2), (a)(3) introductory text, (a)(3)(i) and (iii), (a)(4) introductory text, (a)(4)(i)(B), (a)(4)(ii) and (iii), (a)(5), and (b) and removing paragraph (c).

The revisions read as follows:

**§ 2.34 Bases for filing a trademark or service mark application.**

(a) An application for a trademark or service mark must include one or more of the following five filing bases:

(1) Use in commerce under section 1(a) of the Act. The requirements for an application under section 1(a) of the Act are:

(i) The applicant's verified statement that the mark is in use in commerce. If the verified statement is not filed with the initial application, the verified statement must also allege that the mark was in use in commerce as of the application filing date;

\* \* \* \* \*

(iii) The date of the applicant's first use of the mark in commerce;

(iv) One specimen showing how the applicant uses the mark in commerce; and

(v) If the application specifies more than one item of goods or services in a class, the dates of use in paragraphs (a)(1)(ii) and (iii) of this section are required for only one item of goods or services specified in that class.

(2) Intent-to-use under section 1(b) of the Act. In an application under section 1(b) of the Act, the applicant must verify that the applicant has a bona fide intention to use the mark in commerce. If the verified statement is not filed with the initial application, the verified statement must also allege that the applicant had a bona fide intention to use the mark in commerce as of the application filing date.

(3) Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act. The requirements for an application under section 44(e) of the Act are:

(i) The applicant's verified statement that the applicant has a bona fide intention to use the mark in commerce. If the verified statement is not filed with the initial application, the Office will require submission of the verified statement, which must also allege that the applicant had a bona fide intention to use the mark in commerce as of the application filing date.

\* \* \* \* \*

(iii) If the record indicates that the foreign registration will expire before the U.S. registration will issue, the applicant must submit a true copy, a photocopy, a certification, or a certified copy of a proof of renewal from the applicant's country of origin to establish that the foreign registration has been renewed and will be in full force and effect at the time the U.S. registration will issue. If the proof of renewal is not in the English language, the applicant must submit a translation.

(4) Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act. The requirements for an application under section 44(d) of the Act are:

(i) \* \* \*

(B) State that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority.

(ii) The applicant's verified statement that the applicant has a bona fide intention to use the mark in commerce. If the verified statement is not filed with the initial application, the Office will require submission of the verified statement, which must also allege that the applicant had a bona fide intention to use the mark in commerce as of the application filing date.

(iii) Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under section 1 or 44 of the Act.

(5) Extension of protection of an international registration under section 66(a) of the Act. In an application under section 66(a) of the Act, the international application/subsequent designation must contain a signed declaration that meets the requirements of § 2.33(a), (e).

(b) More than one basis. In an application under section 1 or 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases claimed. In such case, the applicant must specify each basis and the goods or services to which that basis applies. An applicant must specify the goods or services covered by more than one basis. Section 1(a) and 1(b) of the Act may not both be claimed for identical goods or services in the same application. A basis under section 66(a) of the Act may not be combined with another basis.

8. Amend § 2.35 by revising paragraphs (b)(1) and (b)(6) through (8) to read as follows:

**§ 2.35 Adding, deleting, or substituting bases.**

(b) \* \* \*

(1) Before publication for opposition, an applicant may add or substitute a basis, if the applicant meets all requirements for the new basis, as stated in § 2.34, § 2.44, or § 2.45. The applicant may delete a basis at any time.

\* \* \* \* \*

(6) When the applicant adds or substitutes a basis, the applicant must list each basis and specify the goods, services, or collective membership organization to which that basis applies.

(7) When the applicant deletes a basis, the applicant must also delete any goods, services, or collective membership organization covered solely by the deleted basis.

(8) Once an applicant claims a section 1(b) basis as to any or all of the goods or services, or a collective membership organization, the applicant may not amend the application to seek registration under section 1(a) of the Act for identical goods or services or the same collective membership organization, unless the applicant files an allegation of use under section 1(c) or section 1(d) of the Act.

9. Revise § 2.41 to read as follows:

**§ 2.41 Proof of distinctiveness under section 2(f).**

(a) For a trademark or service mark—(1) Ownership of prior registration(s). In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application; however, further evidence may be required.

(2) Five years substantially exclusive and continuous use in commerce. In appropriate cases, if a trademark or service mark is said to have become distinctive of the applicant's goods or services by reason of the applicant's substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) Other evidence. In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the applicant's goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(b) For a collective trademark or collective service mark—(1) Ownership of prior registration(s). See the requirements of paragraph (a)(1) of this section.

(2) Five years substantially exclusive and continuous use in commerce. In appropriate cases, if a collective trademark or collective service mark is said to have become distinctive of the members' goods or services by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) Other evidence. In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the members' goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce, and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(c) For a collective membership mark—(1) Ownership of prior registration(s). In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods, services, or nature of the collective membership organization are sufficiently similar to the collective membership organization in the application; however, further evidence may be required.

(2) Five years substantially exclusive and continuous use in commerce. In appropriate cases, if a collective membership mark is said to have become distinctive of indicating membership in the applicant's collective membership organization by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) Other evidence. In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of indicating membership in the applicant's collective

membership organization, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the members' use in commerce, and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(d) For a certification mark—(1) Ownership of prior certification mark registration(s). In appropriate cases, ownership of one or more active prior certification mark registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the authorized users' goods or services are sufficiently similar to the goods or services certified in the application, subject to the limitations of the statement set forth in § 2.45(a)(4)(i)(C); however, further evidence may be required.

(2) Five years substantially exclusive and continuous use in commerce. In appropriate cases, if a certification mark is said to have become distinctive of the certified goods or services by reason of the authorized users' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) Other evidence. In appropriate cases, where the applicant claims that a mark has become distinctive of the certified goods or services program, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the authorized users' use in commerce and advertising expenditures in

connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(e) Certification marks with geographical matter. Paragraph (d) of this section does not apply to geographical matter in a certification mark certifying regional origin because section 2(e)(2) of the Act does not apply to certification marks that are indications of regional origin.

10. Revise § 2.42 to read as follows:

**§ 2.42 Concurrent use.**

(a) Prior to seeking concurrent use, an application for registration on the Principal Register under the Act must assert use in commerce and include all the application elements required by the preceding sections, in addition to § 2.44 or § 2.45, if applicable.

(b) The applicant must also include a verified statement that indicates the following, to the extent of the applicant's knowledge:

(1) For a trademark or service mark, the geographic area in which the applicant is using the mark in commerce; for a collective mark or certification mark, the geographic area in which the applicant's members or authorized users are using the mark in commerce;

(2) For a trademark or service mark, the applicant's goods or services; for a collective trademark, collective service mark, or certification mark, the applicant's members' or authorized users' goods or services; for a collective membership mark, the nature of the applicant's collective membership organization;

(3) The mode of use for which the applicant seeks registration;

(4) The concurrent users' names and addresses;

(5) The registrations issued to or applications filed by such concurrent users, if any;

(6) For a trademark or service mark, the geographic areas in which the concurrent user is using the mark in commerce; for a collective mark or certification mark, the geographic areas in which the concurrent user's members or authorized users are using the mark in commerce;

(7) For a trademark or service mark, the concurrent user's goods or services; for a collective trademark, collective service mark, or certification mark, the concurrent user's members' or authorized users' goods or services; for a collective membership mark, the nature of the concurrent user's collective membership organization;

(8) The mode of use by the concurrent users or the concurrent users' members or authorized users; and

(9) The time periods of such use by the concurrent users or the concurrent users' members or authorized users.

(c) For the requirements to amend an application to concurrent use, see § 2.73.

(d) For the requirements of a concurrent use proceeding, see § 2.99.

11. Revise § 2.44 to read as follows:

**§ 2.44 Requirements for a complete collective mark application.**

(a) A complete application to register a collective trademark, collective service mark, or collective membership mark must include the following:

(1) The requirements specified in § 2.32(a) introductory text through (a)(4), (a)(8) through (10), (c), and (d);

(2)(i) For a collective trademark or collective service mark, a list of the particular goods or services on or in connection with which the applicant's members use or intend to use the mark; or

(ii) For a collective membership mark, a description of the nature of the membership organization such as by type, purpose, or area of activity of the members; and

(iii) In a U.S. application filed under section 44 of the Act, the scope of the goods or services or the nature of the membership organization covered by the section 44 basis may not exceed the scope of the goods or services or nature of the membership organization in the foreign application or registration.

(3)(i) For a collective trademark or collective service mark application, the international class of goods or services, if known. See § 6.1 of this chapter for a list of the international classes of goods and services; or

(ii) For a collective membership mark application filed under sections 1 or 44 of the Act, classification in U.S. Class 200; and for a collective membership mark application filed under section 66(a) of the Act, the international class(es) assigned by the International Bureau in the corresponding international registration.

(4) One or more of the following five filing bases:

(i) Use in commerce under section 1(a) of the Act. The requirements for an application under section 1(a) of the Act are:

(A) A statement specifying the nature of the applicant's control over the use of the mark by the members;

(B) For a collective trademark or collective service mark, the date of the applicant's member's first use of the mark anywhere on or in connection with the goods or services and the date of the applicant's member's first use of the mark in commerce; or for a collective membership mark, the date of the applicant's member's first use anywhere to indicate membership in the collective organization and the date of the applicant's member's first use in

commerce. If the application specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(C) One specimen showing how a member uses the mark in commerce; and

(D) A verified statement alleging:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons except members have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other persons to cause confusion or mistake, or to deceive; that the specimen shows the mark as used in commerce by the applicant's members; and that the facts set forth in the application are true.

(ii) Intent-to-use under section 1(b) of the Act. The requirement for an application based on section 1(b) of the Act is a verified statement alleging:

That the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods, services, or collective membership organization of such

other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(iii) Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act. The requirements for an application under section 44(e) of the Act are:

(A) The requirements of § 2.34(a)(3)(ii) and (iii); and

(B) A verified statement in accordance with paragraph (a)(4)(ii) of this section.

(iv) Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act. The requirements for an application under section 44(d) of the Act are:

(A) The requirements of § 2.34(a)(4)(i) and (iii); and

(B) A verified statement in accordance with paragraph (a)(4)(ii) of this section.

(v) Extension of protection of an international registration under section 66(a) of the Act.

The requirement for an application under section 66(a) of the Act is a verified statement alleging that the applicant/holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation; that the signatory is properly authorized to execute the declaration on behalf of the applicant/holder; and that to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except members, has the right to use the mark in commerce that the U.S. Congress can regulate either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

(b) Verification not filed within reasonable time or omitted. (1) If the verified statement in paragraph (a)(4)(i)(D), (a)(4)(ii), (a)(4)(iii)(B), or (a)(4)(iv)(B) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce; or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce; or

(2) If the verified statement in paragraph (a)(4)(i)(D), (a)(4)(ii), (a)(4)(iii)(B), (a)(4)(iv)(B), or (a)(4)(v) of this section is not filed with the initial application, the verified statement must also allege that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce; or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce.

(c) More than one basis. In an application under section 1 or 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases claimed. In such case, the applicant must specify each basis, followed by the goods, services, or collective membership organization to which that basis applies. An applicant must specify the goods, services, or collective membership organization covered by more than one basis. Section 1(a) and 1(b) of the Act may not both be claimed for identical goods, or services, or the same collective membership organization in one application. A basis under section 66(a) of the Act may not be combined with another basis.

(d) In an application for concurrent use under § 2.42, the verified statement in paragraph (a)(4)(i)(D) of this section must be modified to indicate that no other persons except members

and the concurrent users as specified in the application have the right to use the mark in commerce.

(e) Multiple-class applications. For the requirements of a multiple-class application, see § 2.86.

12. Revise § 2.45 to read as follows:

**§ 2.45 Requirements for a complete certification mark application; restriction on certification mark application.**

(a) A complete application to register a certification mark must include the following:

(1) The requirements specified in § 2.32(a) introductory text through (a)(4), (a)(8) through (10), (c), and (d);

(2) A list of the particular goods or services on or in connection with which the applicant's authorized users use or intend to use the mark. In an application filed under section 44 of the Act, the scope of the goods or services covered by the section 44 basis may not exceed the scope of the goods or services in the foreign application or registration;

(3) For applications filed under section 1 or 44 of the Act, classification in U.S. Class A for an application certifying goods and U.S. Class B for an application certifying services. For applications filed under section 66(a) of the Act, the international class(es) of goods or services assigned by the International Bureau in the corresponding international registration;

(4) One or more of the following five filing bases:

(i) Use in commerce under section 1(a) of the Act. The requirements for an application under section 1(a) of the Act are:

(A) A statement specifying what the applicant is certifying about the goods or services in the application;

(B) A copy of the certification standards governing use of the certification mark on or in connection with the goods or services specified in the application;

(C) A statement that the applicant is not engaged in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant;

(D) The date of the applicant's authorized user's first use of the mark anywhere on or in connection with the goods or services and the date of the applicant's authorized user's first use of the mark in commerce. If the application specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(E) One specimen showing how an authorized user uses the mark in commerce; and

(F) A verified statement alleging:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons except authorized users have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used in commerce by the applicant's authorized users; and that the facts set forth in the application are true.

(ii) Intent-to-use under section 1(b) of the Act. The requirements for an application based on section 1(b) of the Act are:

(A) A statement specifying what the applicant will be certifying about the goods or services in the application;

(B) A statement that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant; and

(C) A verified statement alleging:

That the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except authorized users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(iii) Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act. The requirements for an application under section 44(e) of the Act are:

(A) The requirements of § 2.34(a)(3)(ii) and (iii);

(B) The requirements in paragraphs (a)(4)(ii)(A) and (B) of this section; and

(C) A verified statement in accordance with paragraph (a)(4)(ii)(C) of this section.

(iv) Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act. The requirements for an application under section 44(d) of the Act are:

- (A) The requirements of § 2.34(a)(4)(i) and (iii);
  - (B) The requirements in paragraphs (a)(4)(ii)(A) and (B) of this section; and
  - (C) A verified statement in accordance with paragraph (a)(4)(ii)(C) of this section.
- (v) Extension of protection of an international registration under section 66(a) of the Act.

The requirements for an application under section 66(a) of the Act are:

- (A) The requirements of paragraphs (a)(4)(ii)(A) and (B) of this section; and
- (B) A verified statement alleging that the applicant/holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation; that the signatory is properly authorized to execute the declaration on behalf of the applicant/holder; and that to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except authorized users, has the right to use the mark in commerce that the U.S. Congress can regulate either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

(b) Verification not filed within reasonable time or omitted. (1) If the verified statement in paragraph (a)(4)(i)(F), (a)(4)(ii)(C), (a)(4)(iii)(C), or (a)(4)(iv)(C) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in

commerce; or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce; or

(2) If the verified statement in paragraph (a)(4)(i)(F), (a)(4)(ii)(C), (a)(4)(iii)(C), (a)(4)(iv)(C), or (a)(4)(v)(B) of this section is not filed with the initial application, the verified statement must also allege that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce; or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce.

(c) More than one basis. In an application under section 1 or 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases claimed. In such case, the applicant must specify each basis, followed by the goods or services to which that basis applies. An applicant must specify the goods or services covered by more than one basis. Section 1(a) and 1(b) of the Act may not both be claimed for identical goods or services in the same application. A basis under section 66(a) of the Act may not be combined with another basis.

(d) Concurrent use. In an application for concurrent use under § 2.42, the verified statement in paragraph (a)(4)(i)(F) of this section must be modified to indicate that no other persons except authorized users and concurrent users as specified in the application have the right to use the mark in commerce.

(e) Multiple-class applications. For the requirements of a multiple-class application, see § 2.86.

(f) Restriction on certification mark application. A single application may not include a certification mark and another type of mark. The same mark for the same goods or services is

not registrable as both a certification mark and another type of mark. See sections 4 and 14(5)(B) of the Act.

13. Amend § 2.56 by revising paragraphs (b)(2), (b)(5), (c), and (d)(3) to read as follows:

**§ 2.56 Specimens.**

\* \* \* \* \*

(b) \* \* \*

(2) A service mark specimen must show the mark as used in the sale or advertising of the services.

\* \* \* \* \*

(5) A certification mark specimen must show how a person other than the owner uses the mark to reflect certification of regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of that person's goods or services; or that members of a union or other organization performed the work or labor on the goods or services.

(c) A photocopy or other reproduction of a specimen of the mark as used on or in connection with the goods, or in the sale or advertising of the services, is acceptable. However, a photocopy of the drawing required by § 2.51 is not a proper specimen.

(d) \* \* \*

(3) In the absence of non-bulky alternatives, a specimen of use in another appropriate medium may be designated as acceptable by the Office.

\* \* \* \* \*

14. Revise § 2.59 to read as follows:

### **§ 2.59 Filing substitute specimen(s).**

(a) In an application under section 1(a) of the Act, the applicant may submit substitute specimens of the mark as used on or in connection with the goods or in the sale or advertising of the services, or as used to indicate membership in the collective organization. The applicant must submit a verified statement that the substitute specimen was in use in commerce at least as early as the filing date of the application. The verified statement is not required if the specimen is a duplicate or facsimile of a specimen already of record in the application.

(b) In an application under section 1(b) of the Act, after filing either an amendment to allege use under § 2.76 or a statement of use under § 2.88, the applicant may submit substitute specimens of the mark as used on or in connection with the goods or in the sale or advertising of the services, or as used to indicate membership in the collective organization. If the applicant submits substitute specimen(s), the applicant must:

(1) For an amendment to allege use under § 2.76, submit a verified statement that the substitute specimen(s) was in use in commerce prior to filing the amendment to allege use.

(2) For a statement of use under § 2.88, submit a verified statement that the substitute specimen(s) was in use in commerce either prior to filing the statement of use or prior to the expiration of the deadline for filing the statement of use.

15. Amend § 2.71 by revising paragraphs (a), (b), (c) introductory text, and (d) and adding paragraph (e) to read as follows:

### **§ 2.71 Amendments to correct informalities.**

\* \* \* \* \*

(a) The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services or the description of the nature of the collective membership organization.

(b)(1) If the verified statement in an application under § 2.33 is unsigned or signed by the wrong party, the applicant may submit a substitute verification.

(2) If the verified statement in a statement of use under § 2.88, or a request for extension of time to file a statement of use under § 2.89, is unsigned or signed by the wrong party, the applicant must submit a substitute verification before the expiration of the statutory deadline for filing the statement of use.

(c) The applicant may amend the dates of use, provided that the amendment is verified, except that the following amendments are *not* permitted:

\* \* \* \* \*

(d) The applicant may amend the application to correct the name of the applicant, if there is a mistake in the manner in which the name of the applicant is set out in the application. The amendment must be verified. However, the application cannot be amended to set forth a different entity as the applicant. An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.

(e) An amendment that would materially alter the certification statement specified in § 2.45(a)(4)(i)(A) or (a)(4)(ii)(A) will not be permitted.

16. Amend § 2.74 by revising paragraph (b) to read as follows:

**§ 2.74 Form and signature of amendment.**

\* \* \* \* \*

(b) Signature. A request for amendment of an application must be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2). If the amendment requires verification, see § 2.2(n).

17. Revise § 2.76 to read as follows:

**§ 2.76 Amendment to allege use.**

(a) When to file an amendment to allege use. (1) An application under section 1(b) of the Act may be amended to allege use of the mark in commerce under section 1(c) of the Act at any time between the filing of the application and the date the examiner approves the mark for publication. Thereafter, an allegation of use may be submitted only as a statement of use under § 2.88 after the issuance of a notice of allowance under section 13(b)(2) of the Act. An amendment to allege use filed outside the time period specified in this paragraph will not be reviewed.

(2)(i) For a trademark, service mark, collective trademark, collective service mark, and certification mark, an amendment to allege use may be filed only when the mark has been in use in commerce on or in connection with all the goods or services specified in the application for which the applicant will seek registration. For a collective membership mark, an amendment to allege use may be filed only when the mark has been in use in commerce to indicate membership in the collective organization specified in the application for which the applicant will seek registration.

(ii) An amendment to allege use may be accompanied by a request in accordance with § 2.87 to divide out from the application the goods, services, or classes not yet in use in commerce.

(b) A complete amendment to allege use. A complete amendment to allege use must include the following:

(1) A verified statement alleging:

(i) The applicant believes the applicant is the owner of the mark;

(ii) The mark is in use in commerce;

(iii) The date of first use of the mark anywhere on or in connection with the goods or services, and/or to indicate membership in the collective organization specified in the application, and the date of first use of the mark in commerce. If the amendment to allege use specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(iv) The goods, services, and/or nature of the collective membership organization specified in the application; and

(v) For a collective mark and certification mark, the applicant is exercising legitimate control over the use in commerce of the mark.

(2) One specimen showing how the applicant, member, or authorized user uses the mark in commerce. See § 2.56 for the requirements for specimens;

(3) The fee per class required by § 2.6;

(4) For a collective mark, the requirements of § 2.44(a)(4)(i)(A);

(5) For a certification mark, the requirements of § 2.45(a)(4)(i)(A)-(C); and

(6) The title “Amendment to Allege Use” should appear at the top of the first page of the document, if not filed through TEAS.

(c) Minimum filing requirements for a timely filed amendment to allege use. The Office will review a timely filed amendment to allege use to determine whether it meets the following minimum requirements:

- (1) The fee required by § 2.6 for at least one class;
- (2) One specimen of the mark as used in commerce; and
- (3) The verified statement in paragraph (b)(1)(ii) of this section.

(d) Deficiency notification. If the amendment to allege use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (c) of this section, the Office will notify the applicant of the deficiency. The deficiency may be corrected provided the mark has not been approved for publication. If an acceptable amendment to correct the deficiency is not filed prior to approval of the mark for publication, the amendment will not be examined, and the applicant must instead file a statement of use after the notice of allowance issues.

(e) Notification of refusals and requirements. A timely filed amendment to allege use that meets the minimum requirements specified in paragraph (c) of this section will be examined in accordance with §§ 2.61 through 2.69. If, as a result of the examination of the amendment to allege use, the applicant is found not entitled to registration for any reason not previously stated, the applicant will be notified and advised of the reasons and of any formal requirements or refusals. The notification shall restate or incorporate by reference all unresolved refusals or requirements previously stated. The amendment to allege use may be amended in accordance with §§ 2.59 and 2.71 through 2.75.

(f) Withdrawal. An amendment to allege use may be withdrawn for any reason prior to approval of a mark for publication.

(g) Verification not filed within reasonable time. If the verified statements in paragraphs (b)(1)(ii) and, if applicable, (b)(1)(v) of this section are not filed within a reasonable time after they are signed, the Office may require the applicant to submit substitute verified statements attesting that the mark is in use in commerce, and, if applicable, the applicant is exercising legitimate control over the use of the mark in commerce.

(h) An amendment to allege use is not a response but may include amendments. The filing of an amendment to allege use does not constitute a response to any outstanding action by the examiner. See § 2.62. The amendment to allege use may include amendments in accordance with §§ 2.59 and 2.71 through 2.75.

(i) If the application is amended to concurrent use under § 2.73, the amendment to allege use must include a verified statement modified in accordance with § 2.33(f), § 2.44(d), or § 2.45(d).

(j) Multiple-class application. For the requirements of a multiple-class application, see § 2.86.

18. Amend § 2.77, by revising paragraphs (a) introductory text and (a)(1) to read as follows:

**§ 2.77 Amendments between notice of allowance and statement of use.**

(a) The only amendments that may be entered in an application between the issuance of the notice of allowance and the submission of a statement of use are:

(1) The deletion of specified goods or services, or the entire description of the nature of the collective membership organization, from the identification;

\* \* \* \* \*

19. Revise § 2.86 to read as follows:

## **§ 2.86 Multiple-class applications.**

(a) In a single application for a trademark, service mark, and/or collective mark, an applicant may apply to register the same mark for goods, services, and/or a collective membership organization in multiple classes. In a multiple-class application, the applicant must satisfy the following, in addition to the application requirements of § 2.32 for a trademark or service mark, and § 2.44 for collective marks:

(1) For an application filed under section 1 or 44 of the Act, identify the goods or services in each international class and/or the nature of the collective membership organization in U.S. Class 200; for applications filed under section 66(a) of the Act, identify the goods, services, and/or the nature of the collective membership organization in each international class assigned by the International Bureau in the corresponding international registration;

(2) Submit the application filing fee required by § 2.6 for each class; and

(3) Include either dates of use and one specimen for each class based on section 1(a) of the Act; or a statement that the applicant has a bona fide intention to use the mark in commerce, for a trademark or service mark, or a statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, for collective marks, for each class based on section 1(b), 44, or 66(a) of the Act. When requested by the Office, additional specimens must be provided.

(b) In a single application for a certification mark, an applicant may apply to register the same certification mark for goods and services. In such case, the applicant must satisfy the following, in addition to the application requirements of § 2.45:

(1) For an application filed under section 1 or 44 of the Act, identify the goods in U.S. Class A and the services in U.S. Class B; for applications filed under section 66(a) of the Act,

identify the goods and services in each international class assigned by the International Bureau in the corresponding international registration;

(2) Submit the application filing fee required by § 2.6 for both classes; and

(3) Include either dates of use and one specimen for each class based on section 1(a) of the Act; or a statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce for each class based on section 1(b), 44, or 66(a) of the Act. When requested by the Office, additional specimens must be provided.

(c) In a single application, both section 1(a) and 1(b) of the Act may not be claimed for identical goods or services.

(d) In a single application based on section 1 or 44 of the Act, goods or services in U.S. Classes A and/or B may not be combined with either goods or services in any international class or with a collective membership organization in U.S. Class 200; and in a single application based on section 66(a) of the Act, a certification mark application may not be combined with goods, services, or a collective membership organization in any international class. See § 2.45(f).

(e) An amendment to allege use under § 2.76 or a statement of use under § 2.88 for multiple classes must include, for each class, the required fee, dates of use, and one specimen. When requested by the Office, additional specimens must be provided. The applicant may not file an amendment to allege use or a statement of use until the applicant has used the mark on or in connection with all the goods, services, or classes, unless the applicant also files a request to divide under § 2.87.

(f) The Office will issue a single certificate of registration for the mark, unless the applicant files a request to divide under § 2.87.

20. Revise § 2.88 to read as follows:

## **§ 2.88 Statement of use after notice of allowance.**

(a) When to file a statement of use. (1) In an application under section 1(b) of the Act, a statement of use, required under section 1(d) of the Act, must be filed within six months after issuance of a notice of allowance under section 13(b)(2) of the Act, or within an extension of time granted under § 2.89. A statement of use filed prior to issuance of a notice of allowance is premature and will not be reviewed.

(2)(i) For a trademark, service mark, collective trademark, collective service mark, and certification mark, a statement of use may be filed only when the mark has been in use in commerce on or in connection with all the goods or services specified in the notice of allowance for which the applicant will seek registration in that application. For a collective membership mark, a statement of use may be filed only when the mark has been in use in commerce to indicate membership in the collective membership organization specified in the notice of allowance for which the applicant will seek registration in that application.

(ii) A statement of use may be accompanied by a request in accordance with § 2.87 to divide out from the application the goods, services, or classes not yet in use in commerce.

(b) A complete statement of use. A complete statement of use must include the following:

(1) A verified statement alleging:

(i) The applicant believes the applicant is the owner of the mark;

(ii) The mark is in use in commerce;

(iii) The date of first use of the mark anywhere on or in connection with the goods, services, and/or to indicate membership in the collective organization specified in the application, and the date of first use of the mark in commerce. If the statement of use specifies

more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(iv) The goods, services, and/or nature of the collective membership organization specified in the notice of allowance. The goods or services specified in a statement of use must conform to those goods or services specified in the notice of allowance for trademark, service mark, collective trademark, collective service mark, or certification mark applications. Any goods or services specified in the notice of allowance that are omitted from the identification of goods or services in the statement of use will be presumed to be deleted and the deleted goods or services may not be reinserted in the application. For collective membership mark applications, the description of the nature of the collective membership organization in the statement of use must conform to that specified in the notice of allowance; and

(v) For a collective mark and certification mark, the applicant is exercising legitimate control over the use in commerce of the mark;

(2) One specimen showing how the applicant, member, or authorized user uses the mark in commerce. See § 2.56 for the requirements for specimens;

(3) Fee(s). The fee required by § 2.6 per class. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the statement of use, or the application will be abandoned. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant should specify the classes to be abandoned. If the applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to be abandoned, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining class(es) or to specify the class(es) to be abandoned. If the applicant does not submit the

required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class, in ascending order. The Office will delete the class(es) not covered by the fees submitted;

(4) For a collective mark, the requirements of § 2.44(a)(4)(i)(A);

(5) For a certification mark, the requirements of § 2.45(a)(4)(i)(A) through (C); and

(6) The title “Statement of Use” should appear at the top of the first page of the document, if not filed through TEAS.

(c) Minimum filing requirements for a timely filed statement of use. The Office will review a timely filed statement of use to determine whether it meets the following minimum requirements:

(1) The fee required by § 2.6 for at least one class;

(2) One specimen of the mark as used in commerce; and

(3) The verified statement in paragraph (b)(1)(ii) of this section. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement on or before the statutory deadline for filing the statement of use.

(d) Deficiency notification. If the statement of use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (c) of this section, the Office will notify the applicant of the deficiency. If the time permitted for the applicant to file a statement of use has not expired, the applicant may correct the deficiency.

(e) Notification of refusals and requirements. A timely filed statement of use that meets the minimum requirements specified in paragraph (c) of this section will be examined in accordance with §§ 2.61 through 2.69. If, as a result of the examination of the statement of use, the applicant is found not entitled to registration, the applicant will be notified and advised of the

reasons and of any formal requirements or refusals. The statement of use may be amended in accordance with §§ 2.59 and 2.71 through 2.75.

(f) Statement of use may not be withdrawn. The applicant may not withdraw a timely filed statement of use to return to the previous status of awaiting submission of a statement of use, regardless of whether it is in compliance with paragraph (c) of this section.

(g) Verification not filed within reasonable time. If the verified statements in paragraphs (b)(1)(ii) and, if applicable, (b)(1)(v) of this section are not filed within a reasonable time after they are signed, the Office may require the applicant to submit substitute verified statements attesting that the mark is in use in commerce, and, if applicable, the applicant is exercising legitimate control over the use of the mark in commerce.

(h) Amending the application. The statement of use may include amendments in accordance with §§ 2.51, 2.59, and 2.71 through 2.75.

(i) Concurrent use. If the application is amended to concurrent use under § 2.73, the statement of use must include a verified statement modified in accordance with § 2.33(f), § 2.44(d), or § 2.45(d).

(j) Multiple-class application. For the requirements of a multiple-class application, see § 2.86.

(k) Abandonment. The failure to timely file a statement of use which meets the minimum requirements specified in paragraph (c) of this section shall result in the abandonment of the application.

21. Revise § 2.89 to read as follows:

**§ 2.89 Extensions of time for filing a statement of use.**

(a) First extension request after issuance of notice of allowance. The applicant may request a six-month extension of time to file the statement of use required by § 2.88. The extension request must be filed within six months of the date of issuance of the notice of allowance under section 13(b)(2) of the Act and must include the following:

(1) A written request for an extension of time to file the statement of use;

(2) The fee required by § 2.6 per class. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the extension request, or the request will be denied. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant should specify the classes to be abandoned. If the applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to be abandoned, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class, in ascending order. The Office will delete the class(es) not covered by the fees submitted; and

(3) A verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying the relevant goods or services, for trademarks or service marks; or that the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, specifying the relevant goods, services, or collective membership organization, for collective marks or certification marks. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement within six months of the date of issuance of the notice of allowance.

(b) Subsequent extension requests. Before the expiration of the previously granted extension of time, the applicant may request further six-month extensions of time to file the statement of use by submitting the following:

(1) A written request for an extension of time to file the statement of use;

(2) The requirements of paragraph (a)(2) of this section for a fee;

(3) A verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying the relevant goods or services, for trademarks or service marks; or that the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, specifying the relevant goods, services, or collective membership organization, for collective marks or certification marks. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement before the expiration of the previously granted extension; and

(4) A showing of good cause, as specified in paragraph (d) of this section.

(c) Four subsequent extension requests permitted. Extension requests specified in paragraph (b) of this section will be granted only in six-month increments and may not aggregate more than 24 months total.

(d) Good cause. A showing of good cause must include:

(1) For a trademark or service mark, a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the relevant goods or services. Those efforts may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain governmental approval, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts to use the mark in commerce.

(2) For a collective mark, a statement of ongoing efforts to make use of the mark in commerce by members on or in connection with each of the relevant goods or services or in connection with the applicant's collective membership organization. Those efforts may include the development of standards, the steps taken to acquire members such as marketing and promotional activities targeted to potential members, training members regarding the standards, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts for applicant's members to use the mark in commerce.

(3) For a certification mark, a statement of ongoing efforts to make use of the mark in commerce by authorized users on or in connection with each of the relevant goods or services. Those efforts may include the development of certification standards, steps taken to obtain governmental approval or acquire authorized users, marketing and promoting the recognition of the certification program or of the goods or services that meet the certification standards of the applicant, training authorized users regarding the standards, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts for applicant's authorized users to use the mark in commerce.

(e) Extension request filed in conjunction with or after a statement of use. (1) An applicant may file one request for a six-month extension of time for filing a statement of use when filing a statement of use or after filing a statement of use if time remains in the existing six-month period in which the statement of use was filed, provided that the time requested would not extend beyond 36 months from the date of issuance of the notice of allowance. Thereafter, applicant may not request any further extensions of time.

(2) A request for an extension of time that is filed under paragraph (e)(1) of this section, must comply with all the requirements of paragraph (a) of this section, if it is an applicant's first

extension request, or paragraph (b) of this section, if it is a second or subsequent extension request. However, in a request under paragraph (b) of this section, an applicant may satisfy the requirement for a showing of good cause by asserting the applicant believes the applicant has made valid use of the mark in commerce, as evidenced by the submitted statement of use, but that if the statement of use is found by the Office to be fatally defective, the applicant will need additional time in which to file a new statement of use.

(f) Goods or services. For trademark, service mark, collective trademark, collective service mark, or certification mark applications, the goods or services specified in a request for an extension of time for filing a statement of use must conform to those goods or services specified in the notice of allowance. Any goods or services specified in the notice of allowance that are omitted from the identification of goods or services in the request for extension of time will be presumed to be deleted and the deleted goods or services may not thereafter be reinserted in the application. For collective membership mark applications, the description of the nature of the collective membership organization in the request for extension of time must conform to that set forth in the notice of allowance.

(g) Notice of grant or denial. The applicant will be notified of the grant or denial of a request for an extension of time, and of the reasons for a denial. Failure to notify the applicant of the grant or denial of the request prior to the expiration of the existing period or requested extension does not relieve the applicant of the responsibility of timely filing a statement of use under § 2.88. If, after denial of an extension request, there is time remaining in the existing six-month period for filing a statement of use, applicant may submit a substitute request for extension of time to correct the defects of the prior request. Otherwise, the only recourse available after denial of a request for an extension of time is to file a petition to the Director in

accordance with § 2.66 or § 2.146. A petition from the denial of an extension request must be filed within two months of the date of issuance of the denial of the request. If the petition is granted, the term of the requested six-month extension that was the subject of the petition will run from the date of expiration of the previously existing six-month period for filing a statement of use.

(h) Verification not filed within reasonable time. If the verified statement in paragraph (a)(3) or (b)(3) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that the applicant has a continued bona fide intention to use the mark in commerce, for trademarks or service marks; or that the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, for collective marks or certification marks.

22. Amend § 2.146 by revising paragraphs (c) and (d) to read as follows:

**§ 2.146 Petitions to the Director.**

\* \* \* \* \*

(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(5). When facts are to be proved on petition, the petitioner must submit proof in the form of verified statements signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.

(d) A petition must be filed within two months of the date of issuance of the action from which relief is requested, unless a different deadline is specified elsewhere in this chapter, and no

later than two months from the date when Office records are updated to show that the registration has been cancelled or has expired.

\* \* \* \* \*

23. Amend § 2.161 by revising paragraphs (b), (c), (d)(1) and (3), and (e) through (h) and adding paragraphs (i) through (k) to read as follows:

**§ 2.161 Requirements for a complete affidavit or declaration of continued use or excusable nonuse.**

\* \* \* \* \*

(b) Include a verified statement attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 8 of the Act. This verified statement must be executed on or after the beginning of the filing period specified in § 2.160(a);

(c) Include the U.S. registration number;

(d)(1) Include the fee required by § 2.6 for each class that the affidavit or declaration covers;

\* \* \* \* \*

(3) If at least one fee is submitted for a multiple-class registration, but the fee is insufficient to cover all the classes, and the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either submission of the additional fee(s) or specification of the class(es) to which the initial fee(s) should be applied. Additional fee(s) may be submitted if the requirements of § 2.164 are met. If the additional fee(s) are not submitted within the time period set out in the Office action and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;

(e)(1) Specify the goods, services, or nature of the collective membership organization for which the mark is in use in commerce, and/or the goods, services, or nature of the collective membership organization for which excusable nonuse is claimed under paragraph (f)(2) of this section; and

(2) Specify the goods, services, or classes being deleted from the registration, if the affidavit or declaration covers fewer than all the goods, services, or classes in the registration;

(f)(1) State that the registered mark is in use in commerce; or

(2) If the registered mark is not in use in commerce on or in connection with all the goods, services, or classes specified in the registration, set forth the date when such use of the mark in commerce stopped and the approximate date when such use is expected to resume; and recite facts to show that nonuse as to those goods, services, or classes is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark; and

(g) Include one specimen showing how the mark is in use in commerce for each class in the registration, unless excusable nonuse is claimed under paragraph (f)(2) of this section. When requested by the Office, additional specimens must be provided. The specimen must meet the requirements of § 2.56.

(h) The Office may require the owner to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the affidavit or declaration under section 8 of the Act.

(i) Additional requirements for a collective mark: In addition to the above requirements, a complete affidavit or declaration pertaining to a collective mark must:

(1) State that the owner is exercising legitimate control over the use of the mark in commerce; and

(2) If the registration issued from an application based solely on section 44 of the Act, state the nature of the owner's control over the use of the mark by the members in the first affidavit or declaration filed under paragraph (a) of this section.

(j) Additional requirements for a certification mark: In addition to the above requirements, a complete affidavit or declaration pertaining to a certification mark must:

(1) Include a copy of the certification standards specified in § 2.45(a)(4)(i)(B);

(i) Submitting certification standards for the first time. If the registration issued from an application based solely on section 44 of the Act, include a copy of the certification standards in the first affidavit or declaration filed under paragraph (a) of this section; or

(ii) Certification standards submitted in prior filing. If the certification standards in use at the time of filing the affidavit or declaration have not changed since the date they were previously submitted to the Office, include a statement to that effect; if the certification standards in use at the time of filing the affidavit or declaration have changed since the date they were previously submitted to the Office, include a copy of the revised certification standards;

(2) State that the owner is exercising legitimate control over the use of the mark in commerce; and

(3) Satisfy the requirements of § 2.45(a)(4)(i)(A) and (C).

(k) For requirements of a complete affidavit or declaration of use in commerce or excusable nonuse for a registration that issued from a section 66(a) basis application, see § 7.37.

24. Amend § 2.167 by revising the introductory text and paragraphs (a) and (c) through (g) and adding paragraphs (h) through (k) to read as follows:

**§ 2.167 Affidavit or declaration under section 15.**

The affidavit or declaration in accordance with § 2.20 provided by section 15 of the Act for acquiring incontestability for a mark registered on the Principal Register or a mark registered under the Trademark Act of 1881 or 1905 and published under section 12(c) of the Act (see § 2.153) must:

(a) Be verified;

\* \* \* \* \*

(c) For a trademark, service mark, collective trademark, collective service mark, and certification mark, recite the goods or services stated in the registration on or in connection with which the mark has been in continuous use in commerce for a period of five years after the date of registration or date of publication under section 12(c) of the Act, and is still in use in commerce; for a collective membership mark, describe the nature of the owner's collective membership organization specified in the registration in connection with which the mark has been in continuous use in commerce for a period of five years after the date of registration or date of publication under section 12(c) of the Act, and is still in use in commerce;

(d) Specify that there has been no final decision adverse to the owner's claim of ownership of such mark for such goods, services, or collective membership organization, or to the owner's right to register the same or to keep the same on the register;

(e) Specify that there is no proceeding involving said rights pending in the Office or in a court and not finally disposed of;

(f) Be filed within one year after the expiration of any five-year period of continuous use following registration or publication under section 12(c) of the Act; and

(g) Include the fee required by § 2.6 for each class to which the affidavit or declaration pertains in the registration. If no fee, or a fee insufficient to cover at least one class, is filed at an appropriate time, the affidavit or declaration will not be refused if the required fee(s) (see § 2.6) is filed in the Office within the time limit set forth in the notification of this defect by the Office. If the submitted fees are insufficient to cover all classes in the registration, the particular class or classes to which the affidavit or declaration pertains should be specified.

(h) If the affidavit or declaration fails to satisfy any of the requirements in paragraphs (a) through (g) of this section, the owner will be notified in an Office action that the affidavit or declaration cannot be acknowledged. If a response is not received within the time period provided or does not satisfy the requirements of the Office action, the affidavit or declaration will be abandoned.

(i) If the affidavit or declaration satisfies paragraphs (a) through (g) of this section, the Office will issue a notice of acknowledgement.

(j) An affidavit or declaration may be abandoned by the owner upon petition to the Director under § 2.146 either before or after the notice of acknowledgement has issued.

(k) If an affidavit or declaration is abandoned, the owner may file a new affidavit or declaration with a new filing fee.

25. Amend § 2.173 by revising paragraphs (b) through (g) and adding paragraphs (h) and (i) to read as follows:

**§ 2.173 Amendment of registration.**

\* \* \* \* \*

(b) Requirements for request. A request for amendment or disclaimer must:

(1) Include the fee required by § 2.6;

(2) Be verified and signed in accordance with § 2.193(e)(6); and

(3) If the amendment involves a change in the mark: one new specimen per class showing the mark as used on or in connection with the goods, services, or collective membership organization; a verified statement that the specimen was in use in commerce at least as early as the filing date of the amendment; and a new drawing of the amended mark. When requested by the Office, additional specimens must be provided.

(4) The Office may require the owner to furnish such specimens, information, exhibits, and affidavits or declarations as may be reasonably necessary to the proper examination of the amendment.

(c) Registration must still contain registrable matter. The registration as amended must still contain registrable matter, and the mark as amended must be registrable as a whole.

(d) Amendment may not materially alter the mark. An amendment or disclaimer that materially alters the character of the mark will not be permitted, in accordance with section 7(e) of the Act.

(e) Amendment of identification of goods, services, or collective membership organization. No amendment in the identification of goods or services, or description of the nature of the collective membership organization, in a registration will be permitted except to restrict the identification or to change it in ways that would not require republication of the mark.

(f) Amendment of certification statement for certification marks. An amendment of the certification statement specified in § 2.45(a)(4)(i)(A) or (a)(4)(ii)(A) that would materially alter the certification statement will not be permitted, in accordance with section 7(e) of the Act.

(g) Conforming amendments may be required. If the registration includes a disclaimer, description of the mark, or other miscellaneous statement, any request to amend the registration

must include a request to make any necessary conforming amendments to the disclaimer, description, or other statement.

(h) Elimination of disclaimer. No amendment seeking the elimination of a disclaimer will be permitted, unless deletion of the disclaimed portion of the mark is also sought.

(i) No amendment to add or delete section 2(f) claim of acquired distinctiveness. An amendment seeking the addition or deletion of a claim of acquired distinctiveness will not be permitted.

26. Amend § 2.175 by revising paragraph (b)(2) to read as follows:

**§ 2.175 Correction of mistake by owner.**

\* \* \* \* \*

(b) \* \* \*

(2) Be verified; and

\* \* \* \* \*

27. Amend § 2.183 by revising paragraphs (d) and (e) to read as follows:

**§ 2.183 Requirements for a complete renewal application.**

\* \* \* \* \*

(d) If the renewal application covers less than all the goods, services, or classes in the registration, then a list specifying the particular goods, services, or classes to be renewed.

(e) If at least one fee is submitted for a multiple-class registration, but the fee is insufficient to cover all the classes and the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of § 2.185 are met. If the required fee(s) are not submitted and the class(es) to which

the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class.

\* \* \* \* \*

28. Amend § 2.193 by revising paragraphs (c)(2), (e) introductory text, (e)(1), and (f) to read as follows:

**§ 2.193 Trademark correspondence and signature requirements.**

\* \* \* \* \*

(c) \* \* \*

(2) Sign the document using some other form of electronic signature specified by the Director.

\* \* \* \* \*

(e) Proper person to sign. Documents filed in connection with a trademark application or registration must be signed by a proper person. Unless otherwise specified by law, the following requirements apply:

(1) Verified statement of facts. A verified statement in support of an application for registration, amendment to an application for registration, allegation of use under § 2.76 or § 2.88, request for extension of time to file a statement of use under § 2.89, or an affidavit under section 8, 12(c), 15, or 71 of the Act must satisfy the requirements of § 2.2(n), and be signed by the owner or a person properly authorized to sign on behalf of the owner. A person who is properly authorized to verify facts on behalf of an owner is:

\* \* \* \* \*

(f) Signature as certification. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-

practitioner, constitutes a certification under § 11.18(b) of this chapter. Violations of § 11.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under § 11.18(c) of this chapter. Any practitioner violating § 11.18(b) of this chapter may also be subject to disciplinary action. See § 11.18(d) and § 11.804 of this chapter.

\* \* \* \* \*

## **PART 7—RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

29. The authority citation for part 7 continues to read as follows:

**Authority:** 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

30. Amend § 7.1 by revising paragraph (c) and adding paragraph (f) to read as follows:

### **§ 7.1 Definitions of terms as used in this part.**

\* \* \* \* \*

(c) The acronym TEAS means the Trademark Electronic Application System, available at <http://www.uspto.gov>.

\* \* \* \* \*

(f) The definitions specified in § 2.2(k) and (n) of this chapter apply to this part.

31. Amend § 7.37 by revising paragraphs (b) introductory text, (b)(1), (d)(1), (d)(3), (e), (f)(1), (g), and (h) and adding paragraphs (i) and (j) to read as follows:

### **§ 7.37 Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse.**

\* \* \* \* \*

(b) Include a verified statement attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 71 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in § 7.36(b). A person who is properly authorized to sign on behalf of the holder is:

(1) A person with legal authority to bind the holder;

\* \* \* \* \*

(d)(1) Include the fee required by § 7.6 for each class that the affidavit or declaration covers;

\* \* \* \* \*

(3) If at least one fee is submitted for a multiple-class registration, but the fee is insufficient to cover all the classes and the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either submission of the additional fee(s) or specification of the class(es) to which the initial fee(s) should be applied. Additional fees may be submitted if the requirements of § 7.39 are met. If the additional fee(s) are not submitted within the time period set out in the Office action and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;

(e)(1) Specify the goods, services, or nature of the collective membership organization for which the mark is in use in commerce, and/or the goods, services, or nature of the collective membership organization for which excusable nonuse is claimed under paragraph (f)(2) of this section; and

(2) Specify the goods, services, or classes being deleted from the registration, if the affidavit or declaration covers fewer than all the goods, services, or classes in the registration;

(f)(1) State that the registered mark is in use in commerce; or

(2) If the registered mark is not in use in commerce on or in connection with all the goods, services, or classes specified in the registration, set forth the date when such use of the mark in commerce stopped and the approximate date when such use is expected to resume; and recite facts to show that nonuse as to those goods, services, or classes is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark; and

(g) Include one specimen showing how the mark is in use in commerce for each class in the registration, unless excusable nonuse is claimed under paragraph (f)(2) of this section. When requested by the Office, additional specimens must be provided. The specimen must meet the requirements of § 2.56 of this chapter.

(h) The Office may require the holder to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the affidavit or declaration under section 71 of the Act.

(i) Additional requirements for a collective mark: In addition to the above requirements, a complete affidavit or declaration pertaining to a collective mark must:

(1) State that the holder is exercising legitimate control over the use of the mark in commerce; and

(2) State the nature of the holder's control over the use of the mark by the members in the first affidavit or declaration filed under paragraph (a) of this section.

(j) Additional requirements for a certification mark: In addition to the above requirements, a complete affidavit or declaration pertaining to a certification mark must:

(1) Include a copy of the certification standards specified in § 2.45(a)(4)(i)(B) of this chapter;

(i) Submitting certification standards for the first time. In the first affidavit or declaration filed under paragraph (a) of this section, include a copy of the certification standards; or

(ii) Certification standards submitted in prior filing. If the certification standards in use at the time of filing the affidavit or declaration have not changed since the date they were previously submitted to the Office, include a statement to that effect; if the certification standards in use at the time of filing the affidavit or declaration have changed since the date they were previously submitted to the Office, include a copy of the revised certification standards;

(2) State that the holder is exercising legitimate control over the use of the mark in commerce; and

(3) Satisfy the requirements of § 2.45(a)(4)(i)(A) and (C) of this chapter.

Date: June 5, 2015

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Russell Slifer,  
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Intellectual Property and Deputy Director of the  
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[FR Doc. 2015-14267 Filed: 6/10/2015 08:45 am; Publication Date: 6/11/2015]